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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------|-------------|----------------------|----------------------------------|------------------|
| 10/790,934 | 03/02/2004 | Jay S. Walker | 3718582-00118 | 3244 |
| 29159 | 7590 | 07/14/2010 | | |
| K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690 | | | EXAMINER RUSTEMEYER, MALINA K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3714 | |
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| | | | 07/14/2010 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

| | | | |
|------------------------------|-----------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/790,934 | Applicant(s) WALKER ET AL. | |
| | Examiner Malina K. Rustemeyer | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's response filed on 4/29/09.
Applicant amends claim 1 and responds to rejections. Claims 1, 3, 4, 6-12, and 14 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 3, 4, 6-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 6312332 B1) in view of Acres (US 5655961).

Concerning claim 1, Walker teaches a method of operating a gaming system, said method comprising: (a) at a first point in time, causing at least one processor of a wagering game device to execute a plurality of instructions **[Abstract]**, (i) determine a

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current time **[Fig. 7 (current time is now)]**; and determine a reference time **[Fig. 7, item 98 (30, 60, or 120 seconds in the future)]**. Walker teaches wherein, at the first point in time, the determined reference time is different than the determined current time **[Fig. 7]**; and (b) at a second, different point in time (time between current and reference), causing the at least one processor to execute the plurality of instructions **[column 8, lines 15-45]** to: (i) determine that the second point in time has a predetermined relationship to the determined reference time **[column 8, lines 15-45 (the second point in time is before the reference time)]**; and (ii) in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, said first play of the bonus game said first play of the bonus game being displayed distinct and independent from any outcome being generated during any play of any game having a first average expected payout which is based, at least in part, on the second point in time having the predetermined relationship to the determined reference time **[column 8, lines 15-45 (the bonus game is to obtain one additional royal flush among 5 players)]**. Walker lacks teaching a third different point in time. Acres teaches (c) at a third, different point in time, causing the at least one processor to execute the plurality of instructions to: (i) determine that a triggering event has occurred, the triggering event occurring independent of the third point in time **[column 26, lines 1-21 and column 29, lines 1-8]**; and (ii) cause the at least one display device to display a second, different play of the bonus game, said second, different play of the bonus game having a second, different average expected payout **[column 26, lines 1-21 and column 29, lines 1-8]**.

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Acres teaches, as an example, a minimum activity level of handle pulls or coin-in at a gaming machine over a designated period to time which activates a trigger condition to allow the player access to another jackpot. It would have been obvious to one with ordinary skill in the art, at the time of the invention to have modified the gaming system disclosed by Walker et al. to allow the reference time to provide players' eligibility to achieve an award as disclosed by Acres et al. to verify active player participation, and providing added incentive to allow even losing players to continue playing.

Furthermore, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 3, Walker teaches the time interval to implement the bonus period and to set a reference first time can be set up at intervals by casinos or the gaming facility **[column 13, line 61- column 14, line 26]**. Wherein the time limits can be set by the casino, determining a reference time includes determining a beginning of a next hour would be design choice of the casino.

Concerning claim 4, Walker teaches the time interval to implement the bonus period and to set a reference first time can be set up at intervals by casinos or the gaming facility **[column 13, line 61- column 14, line 26]**. Wherein the time limits can be set by the casino, determining a time that is a predetermined number of minutes before a beginning of a next hour would be design choice of the casino.

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Concerning claim 6, Acres teaches determining whether a player has satisfied at least one criterion; wherein the display of said first play of said bonus game is based, at least in part, on the player satisfying the at least one criterion **[column 26, lines 1-10 and column 29, lines 1-8]**. Acres teaches, as an example, a minimum activity level of handle pulls or coin-in at a gaming machine over a designated period to time which activates a trigger condition to allow the player access to another jackpot. It would have been obvious to one with ordinary skill in the art, at the time of the invention to have modified the gaming system disclosed by Walker et al. to allow the reference time to provide players' eligibility to achieve an award as disclosed by Acres et al. to verify active player participation, and providing added incentive to allow even losing players to continue playing. Furthermore, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 7, Acres teaches determining whether a player has satisfied at least one criterion includes determining whether the player has made a specified number of handle pulls at the wagering gaming device **[column 26, lines 1-10 and column 29, lines 1-8]**. Acres teaches, as an example, a minimum activity level of handle pulls or coin-in at a gaming machine over a designated period to time which activates a trigger condition to allow the player access to another jackpot. It would have been obvious to one with ordinary skill in the art, at the time of the invention to have modified the gaming system disclosed by Walker et al. to allow the reference time to

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provide players' eligibility to achieve an award as disclosed by Acres et al. to verify active player participation, and providing added incentive to allow even losing players to continue playing. Furthermore, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 8, Acres teaches determining whether a player has satisfied at least one criterion includes determining whether the player has made a specified number of handle pulls at the wagering game device within a time interval beginning a specified period of time prior to the determined reference time, and ending with the first-determined reference time **[column 26, lines 1-21 and column 29, lines 1-8]**. Acres teaches, as an example, a minimum activity level of handle pulls or coin-in at a gaming machine over a designated period to time which activates a trigger condition to allow the player access to another jackpot. Walker teaches the time interval to implement the bonus period and to set a reference first time can be set up at intervals by casinos or the gaming facility **[column 13, line 61- column 14, line 26]**. Wherein the time limits can be set by the casino, determining a time that is a predetermined number of minutes before a beginning of a next hour would be design choice of the casino. It would have been obvious to one with ordinary skill in the art, at the time of the invention to have modified the gaming system disclosed by Walker et al. to allow the reference time to provide players' eligibility to achieve an award as disclosed by Acres et al. to verify active player participation, and providing added incentive to allow even losing players to

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continue playing. Furthermore, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 9, Acres teaches wherein determining whether a player has satisfied at least one criterion includes determining whether the player has made a specified number of handle pulls at the wagering game device within a time interval prior to the determined reference time, and ending with the determined reference time **[column 26, lines 1-21 and column 29, lines 1-8]**. Acres teaches, as an example, a minimum activity level of handle pulls or coin-in at a gaming machine over a designated period to time which activates a trigger condition to allow the player access to another jackpot. Walker teaches the time interval to implement the bonus period and to set a reference first time can be set up at intervals by casinos or the gaming facility **[column 13, line 61- column 14, line 26]**. Wherein the time limits can be set by the casino, determining a time that is a predetermined number of minutes before a beginning of a next hour would be design choice of the casino. It would have been obvious to one with ordinary skill in the art, at the time of the invention to have modified the gaming system disclosed by Walker et al. to allow the reference time to provide players' eligibility to achieve an award as disclosed by Acres et al. to verify active player participation, and providing added incentive to allow even losing players to continue playing.

Furthermore, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in

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their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 10, Acres teaches determining whether a player has satisfied at least one criterion includes determining whether the player has wagered, at a gaming device, an amount of currency whose aggregate value is at least a specified value, within a time interval beginning a specified period of time prior to the determined reference time, and ending with the determined reference time **[column 26, lines 1-21 and column 29, lines 1-8]**. The amount wagered, directly corresponds to the period of time. Acres teaches, as an example, a minimum activity level of handle pulls or coin-in at a gaming machine over a designated period to time which activates a trigger condition to allow the player access to another jackpot. Walker teaches the time interval to implement the bonus period and to set a reference first time can be set up at intervals by casinos or the gaming facility **[column 13, line 61- column 14, line 26]**. Wherein the time limits can be set by the casino, determining a time that is a predetermined number of minutes before a beginning of a next hour would be design choice of the casino. It would have been obvious to one with ordinary skill in the art, at the time of the invention to have modified the gaming system disclosed by Walker et al. to allow the reference time to provide players' eligibility to achieve an award as disclosed by Acres et al. to verify active player participation, and providing added incentive to allow even losing players to continue playing. Furthermore, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions,

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and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claims 11, 12 and 14, Walker is silent on player tracking capabilities. Acres et al. teaches determining whether a player has satisfied at least one criterion includes determining whether the player has: paid in taxes to the wagering game device, an amount of currency whose aggregate value is at least a specified value, within a time interval beginning a specified period of time prior to the reference time, and ending with the reference time and/or a specified average rate of play at a gaming device within a time interval beginning a specified period of time prior to the reference time, and ending with the reference time, and/or paid a fee to a gaming device in exchange for insurance that the player will be provided entry into a bonus game **[column 3, lines 13-37 and column 25, line 38- column 26, line 24]**. Acres et al. teaches improved player tracking by recording each and every machine transaction including time of play, machine number, duration of play, coins in, coins out, hand paid jackpots and games played. The player tracking is conducted over the same network as the accounting data is extracted. It would be obvious to substitute Acres player tracking system into the Walker gaming system to allow the invention to provide bonusing to certain individual players as well as during certain times. As with standard player tracking, the above-described system monitors and reports how many coins are played by each player. The system according to the invention, however, also includes the ability to record how long each player spends at each machine and the number of coins won, games played, and hand jackpots won by each player. Examiner takes

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official notice of taxes paid to a gaming device, determining an average rate of play, and paying insurance are well known to one of ordinary skill in the art. It would be obvious substitute these features into the Walker gaming system to provide extra fees to the casino, and measure player progress. Furthermore the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Examiner's Note

5. The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3, 4, 6-12, and 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malina K. Rustemeyer whose telephone number is (571)270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

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Examiner
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